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EXAMINER

NAJEE-ULLAH, TARIQ S

ART UNIT	PAPER NUMBER
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2152

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,799	Applicant(s) ANDREEV ET AL.	
	Examiner TARIQ S. NAJEE-ULLAH	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/12/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is the first Office action in response to Application 10/777,799 filed on 12 February 2004. Claims 1-12 have been examined and are pending.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12 February 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 6-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 6 recites "a messaging system." This is read as a software system since it does not include any hardware structure. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 7-11 recite "a program storage device." The program storage device is not limited to statutory subject matter. In view of Applicant's

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disclosure, Fig. 5 and par. [0035], a program storage device is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., "... magnetic medium and optical medium..." fig. 5 and par. [0035]) and intangible embodiments (e.g., "...transmission medium ..." fig. 5 and par. [0035]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim 12 recites "a computer program product." The computer program product is not limited to statutory subject matter. In view of Applicant's disclosure, Fig. 5 and par. [0035], a computer program product is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., "... magnetic medium and optical medium..." fig. 5 and par. [0035]) and intangible embodiments (e.g., "...transmission medium ..." fig. 5 and par. [0035]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1, 7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 6,212,548 to DeSimone et al (DeSimone hereinafter).

Regarding claims 1, 7, and 12 DeSimone teaches **first receiving from a first user a request to enter chat mode with a second user** (Fig. 3); **second receiving asynchronously from said second user a request to download any content from said server or any other intranet or Intranet server** (Col. 2, lines 42-47); **responding to said request from said second user** (Col. 5, lines 35-60; DeSimone teaches the components of a message conversation including the originating user, recipients, and a conversation index. DeSimone further teaches that a participant, i.e. second user in the conversation can respond to the originating user by joining the conversation or removing him or herself from the conversation.) **with said content modified to instantiate a chat session between said first user and said second user** (Col. 2, lines 49-56).

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 7,263,526 to Busey et al (Busey hereinafter).

Regarding claim 6, Busey teaches **a first user browser** (Fig. 3, RTM chat client 314); **a second user browser** (Fig. 3, RTM chat client 334); **a communication network interconnecting said first user browser and said second user browser through a common server** (Fig. 3; RTM chat clients 314 and 334 interconnect via a common server 324); **a message engine at said common server for: first receiving from said first user browser a request to enter chat mode with said second user browser** (Fig. 2 depicts a user launching a chat session via HTML, i.e. a browser. It is inherent that a request to enter a chat mode has been received and accepted by the second user as fig. 3 shows established communication

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between chat client 314 and 334.); **second receiving asynchronously from said second user browser a request to download any content from said common server or any other intranet or Internet server** (Fig. 6; Col. 6, lines 51-61); **responding to said request from said second user** (Fig. 3, Col. 6, lines 12-45; Busey teaches the real time markup (RTM) communication between a first user "Sarah" and a second user "Sam." The originating message from Sarah evokes a response over the RTM chat client initiating contact with the real-time server and negotiating a connection with Sam's RTM chat client.) **browser with said content modified to instantiate a chat session between said first user browser and said second user browser** (Fig. 6; Col. 6, lines 51-61).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5,8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,212,548 to DeSimone et al

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(DeSimone hereinafter) as applied to claims 1, 7, and 12 above, and further in view of US Patent Number 7,263,526 to Busey et al (Busey hereinafter).

Regarding claims 2 and 8, DeSimone teaches **said first user downloading from said server browser executable code for initiating a chat session; executing at a first browser said browser executable code to display a chat invitation form including a header field, and instruction field, one or more fields for entering user identifiers, and a message field at a first browser** (Figs. 3-5; Col. 6, lines 15-17, 45-56 shows the invitation message instructions sent to the communication server including a header, instructions, identifiers, and a message.); **said first user entering to said chat invitation form one or more user identifiers including a user identifier for said second user, and optionally a message to said message field** (Figs. 3-5 and associated text illustrate the process by showing screenshots of a first users (Dawn's) browser window initiating a chat invitation with a second user (Mike) and subsequently adding another user (Dave)); **establishing a persistent connection between said first browser and said server** (Fig. 7 shows ongoing communication between first browser user and others. Fig. 2A shows this taking place over a server); **and submitting said request to said server including data entered to said chat invitation form** (Fig. 7

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shows ongoing communication between first browser user and others. Fig. 2A shows this taking place over a server). DeSimone does not teach **said first user downloading from said server browser executable code for initiating a chat session.**

Busey teaches **said first user downloading from said server browser executable code for initiating a chat session** (Busey, Col. 15, lines 43-48).

DeSimone and Busey are analogous art because they are from the same field of endeavor of managing chat functions and applications in a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Busey's embedding of chat functions in a web page as part of DeSimone's system and method for multiple asynchronous text chat conversations.

The suggestion/motivation would have been to overcome the limitations and inflexibility of existing HTML chat programs (Busey, Col. 2, lines 17-24).

Regarding claims 3 and 9, DeSimone teaches **responsive to said second receiving, determining that said second user requesting content from said server is that user identified by said user identifier for said second user** (Figs. 3-5 and associated text illustrate the process

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by showing screenshots of a first users (Dawn's) browser window initiating a chat invitation with a second user (Mike) and subsequently adding another user (Dave)); **serving to said second user said content modified to instantiate at a second browser a window including a header field, a messages field, and a response field** (Figs. 3-5; Col. 6, lines 15-17, 45-56 shows the message instructions sent to the communication server including a header, instructions, identifiers, and a message.); **establishing a persistent connection between said second browser and said server to establish a channel for message exchange between said first and second browsers with said server acting as proxy** (Fig. 7 shows ongoing communication between first browser user and others. Fig. 2A shows this taking place over a server).

Regarding claims 4 and 10, DeSimone teaches **responsive to said second receiving, determining that said second user requesting content from said server is that user identified by said user identifier for said second user** (Figs. 3-5 and associated text illustrate the process by showing screenshots of a first users (Dawn's) browser window initiating a chat invitation with a second user (Mike) and subsequently adding another user (Dave) and having ongoing communication via a chat conversation.); **serving to said second user a response including code selectively replacing or appended to said content for instantiating at a second**

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browser a window including a header field, a messages field, and a response field; establishing a persistent connection between said second browser and said server to establish a channel for message exchange between said first and second browsers with said server

acting as proxy (Fig. 7 shows ongoing communication between first browser user and others. Fig. 2A shows this taking place over a server).

DeSimone does not teach **serving to said second user a response including code selectively replacing or appended to said content for instantiating at a second browser a window including a header field, a messages field, and a response field.**

Busey teaches **serving to said second user a response including code selectively replacing or appended to said content for instantiating at a second browser a window including a header field, a messages field, and a response field.** (Busey, Col. 16, lines 18-51).

DeSimone and Busey are analogous art because they are from the same field of endeavor of managing chat functions and applications in a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Busey's embedding of chat functions in a web page as part of DeSimone's system and method for multiple asynchronous text chat conversations.

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The suggestion/motivation would have been to overcome the limitations and inflexibility of existing HTML chat programs (Busey, Col. 2, lines 17-24).

Regarding claims 5 and 11, DeSimone teaches the limitations of claim 4 and claim 10 but does not teach the further limitations of claims 5 and 11. Busey teaches **authenticating said first user to a message engine at said server to enable unicast messaging capabilities** (Fig. 6; Col. 6, lines 51-61); **and thereafter serving to said first user, in response to an asynchronous message from said first user requesting server content** (Fig. 6; Col. 6, lines 51-61), **a user interface to a collaboration tool for conveying text and/or multimedia messages with respect to said first user and an administration server** (Figs. 6,9).

DeSimone and Busey are analogous art because they are from the same field of endeavor of managing chat functions and applications in a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Busey's embedding of chat functions in a web page as part of DeSimone's system and method for multiple asynchronous text chat conversations.

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The suggestion/motivation would have been to overcome the limitations and inflexibility of existing HTML chat programs (Busey, Col. 2, lines 17-24).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent Publication 6,785,708 to Busey titled, "Method and apparatus for synchronizing browse and chat functions on a computer network."
- US Patent Publication 5,862,330 to Anupam et al titled, "Technique for obtaining and exchanging information on World Wide Web."
- US Patent Publication 6,785,708 to England titled, "System and method for managing interactions between users in a browser-based telecommunications network."
- US Patent Publication 6,660,644 to Ford et al titled, "System and technique for dynamic information gathering and targeted advertising in a web based model using a live information selection and analysis tool."
- US Patent Publication 6,442,590 to Inala et al titled, "Method and apparatus for a site-sensitive interactive chat network."
- US Patent Publication 6,857,006 to Nishizawa titled, "Multimedia direct communication system linked with HTTP protocol."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARIQ S. NAJEE-ULLAH whose telephone number is (571)270-5013. The examiner can normally be reached on Monday through Friday 8:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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T. N.

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152